

REMARKS

Claims 51, 53-55, 57, 59, 61-70, 82, 84-86, 88, 90, and 107-109 are pending in this application. Claims 51, 65, 66, 67 and 82 have been hereinabove amended.

Claims 51 and 82 have been amended to recite, *inter alia*, that the other linking group of N or P is selected from the group consisting of one or more amino acids, a hydrocarbon chain of the formula R₁-(CH₂)_n-R₂ or a combination thereof, wherein n is 0-10, R₁ is a group that can be used as a site for covalently linking M; and R₂ is a group that is used for covalent coupling to the N-terminal NH₂-group of G. These amendments are supported throughout the specification, particularly at paragraphs 00167-00170.

In claims 65-68 the language requested by the Examiner has been substituted (replacing “subject” with “patient”). Likewise, in claims 51 and 82 the language requested by the Examiner has been substituted (replacing “N is 0” and “P is 0” with “N is absent” and “P is absent”).

Therefore, no new matter has been introduced by the above amendments to the claims.

Applicants note the withdrawal of the prior rejections under 35 U.S.C § 103.

Non-Statutory Double Patenting Rejections

The Examiner maintained the rejection of the pending claims under the judicially created doctrine of obviousness-type double patenting based on the claims of one issued patent and provisionally rejected the pending claims based on the claims of several pending applications. More specifically, the Examiner rejected the pending claims as being allegedly unpatentable over U.S. Patent No. 7,226,577 and provisionally rejected the pending claims based on U.S. Serial Nos. 10/542,202; 11/165,721; 11/352,156; 11/467,237; 11/467,301 and 10/566,112. Applicants address each obviousness-type double patenting rejection in turn:

U.S. Patent No. 7,226,577

While applicants disagree with the Examiner's basis for the obviousness-type double patenting rejection over U.S. Patent No. 7,226,577 ("‘577 patent"), solely to speed prosecution, applicants will execute and file a terminal disclaimer over the ‘577 patent once claims are held allowable.

USSN 10/542,202

Applicants note that the obviousness-type double patenting rejection over USSN 10/542,202 is provisional in nature. Applicants respectfully request that this rejection be held in abeyance until such time as claims become allowable.

USSN 11/165,721

Applicants note that the obviousness-type double patenting rejection over USSN 11/165,721 is provisional in nature. Applicants respectfully request that this rejection be held in abeyance until such time as claims become allowable.

USSN 11/352,156

With respect to the obviousness-type double patenting rejection over USSN 11/352,156 ("‘156 application"), applicants point out that the ‘156 application was filed after the instant case. Thus, any obviousness-type double patenting rejection is better dealt with in the ‘156 application.

USSN 11/467,237

USSN 11/467,237 ("‘237 application") is a divisional application filed in response to a restriction requirement in USSN 10/341,577 ("‘577 application") (issued as U.S. Patent No. 7,226,577), which is also the parent of the instant case. The restriction requirement in the ‘577 application stated that non-alpha amino acid linkers were patentably distinct from non-alpha amino acid with cyclic group linkers. Since the claims of the present application are

directed to non-alpha amino acid with cyclic group linkers, applicants respectfully submit that it is impossible for the non-alpha amino acid with cyclic group linkers to result in obvious-type double patenting over the '237 application linkers, when both groups of linkers were subject to restriction in the parent case.

Furthermore, in the instant case, the Examiner has again separated the linker classes into different groups. Thus, linker classes have been consistently treated as patentably distinct throughout the prosecution of this patent family.

Therefore, because the obvious-type double patenting rejection is improper for at least the above reasons, applicants respectfully request withdrawal of the same.

USSN 11/467,301

USSN 11/467,301 ("301 application") is a divisional application filed in response to a restriction requirement in USSN 10/341,577 ("577 application") (issued as U.S. Patent No. 7,226,577), which is also the parent of the instant case. The restriction requirement in the '577 application stated that bile acid derivative linkers were patentably distinct from non-alpha amino acid with cyclic group linkers. Since the claims of the present application are directed to non-alpha amino acid with cyclic group linkers, applicants respectfully submit that it is impossible for the non-alpha amino acid with cyclic group linkers to result in obvious-type double patenting over the '301 application linkers, when both groups of linkers were subject to restriction in the parent case.

Furthermore, in the instant case, the Examiner has again separated the linker classes into different groups. Thus, linker classes have been consistently treated as patentably distinct throughout the prosecution of this patent family.

Therefore, because the obvious-type double patenting rejection is improper for at least the above reasons, applicants respectfully request withdrawal of the same.

USSN 10/566,112

With respect to the obviousness-type double patenting rejection over USSN 10/566,112 (“112 application”), applicants point out that the ‘112 application was filed after the instant case. Thus, any obviousness-type double patenting rejection is better dealt with in the ‘112 application.

For the above reasons applicants respectfully request that the double patenting rejection and provisional double patenting rejections be held in abeyance or withdrawn as discussed above. When the instant claims are determined to contain allowable subject matter, applicants will consider submitting a terminal disclaimer where appropriate.

35 U.S.C. 112, ¶ 2

Applicants are grateful for the withdrawal of certain rejections under 35 U.S.C. 112, ¶ 2.

The Examiner has maintained the rejection of claims 51 and 82 for alleged indefiniteness due to the recitation of the phrase “other linking group”. Applicants submit that the claims are sufficiently definite given the definition of other linking groups at paragraphs 167-171 of the specification. However, solely to expedite prosecution, applicants have amended claims 51 and 82 to require that the other linking group of N or P is selected from the group consisting of one or more amino acids, a hydrocarbon chain of the formula $R_1-(CH_2)_n-R_2$ or a combination thereof, wherein n is 0-10, R_1 is a group that can be used as a site for covalently linking M; and R_2 is a group that is used for covalent coupling to the N-terminal NH_2 -group of G.

Thus, in light of the above, applicants submit that the § 112 ¶ 2 rejection of claims 51 and 82 is now moot.

In view of the foregoing, applicants respectfully submit that the presently pending claims are in condition for allowance. If a telephone interview would be of assistance in advancing prosecution of this application, Applicant's undersigned attorney encourages the Examiner to telephone him at the number provided below.

No fee is believed to be necessary in connection with the filing of this Amendment and Response to Office Action. If any additional fee is necessary, however, applicant hereby authorizes such fee to be charged to Deposit Account No. 50-0540.

Respectfully submitted,

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